

REMARKS

Claims 26-32, 34-40, and 42 are pending. Claims 33, 41, 52 and 53 are canceled without prejudice to their presentation in another application. Claims 26, 36-38, 39, and 42 are amended. The basis for the amendments to claims 26 and 38 can be found, for example, at page 4, line 21 to page 6, line 20. Claim 36 is amended to correct a typographical error. Claims 34, 37, 38, and 42 are amended to conform the claims with other amendments.

Claims 26-37 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for not having a step indicating that a reaction occurs. While Applicants do not agree that such a step need be explicitly recited, claim 26 is amended in order to further prosecution.

Claims 26-27, 29, 32, 35-40, and 42 stand rejected as allegedly anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 5,449,754 ("the Nishioka patent") or U.S. Patent No. 5,847,105 ("the Baldeschwieler patent"). Claims 26, 35-40, and 42 stand rejected as allegedly anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 5,474,796 ("the Brennan patent") or U.S. Patent No. 5,677,195 ("the Winkler patent"). Although Applicants do not necessarily agree with the allegations, claims 26 and 38 are amended to recite a step utilizing a collection plate. Because the standard for anticipation is strict identity and, as admitted in the Office Action (pages 7-9), the aforementioned collection feature is not disclosed in the cited art, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 28, 30, 31, 33, 34, and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over the Nishioka patent or the Baldeschwieler patent in view of the alleged admitted state of the prior art, U.S. Patent No. 4,923,901 ("the Koester patent") and Salmon, *et al.* *Proc. Natl. Acad. Sci. USA* **1993**, 90, 11708-12 ("the Salmon article"). Before a rejection for alleged obviousness can be predicated on a "combination of references," however, some motivation to combine the teachings of the prior art must be identified. An invention is not obvious under the patent laws simply because it is theoretically possible with the aid of hindsight to combine references in a manner that will yield the claimed invention. The prior art itself must suggest the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In other words, "the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no

knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

In the instant rejection, the Office Action admits (pages 7-9) that the Nishioka patent and the Baldeschwieler patent do not disclose collection of the reaction product on a collection plate. Furthermore, the aforementioned patents do not disclose the use of such a plate at a position adjacent to a second surface on the reaction support. Neither the Koester patent nor the art discussed at page 15, line 22 to page 16, line 3 of the instant specification cures this defect. The remaining cited art, the Salmon article, is directed to a collection process that is significantly different than the instant process. The process of the Salmon article is one where a peptide is constructed on a bead, the bead is then placed in a filtration well, and then a portion of the peptide is removed and collected (see, for example, page 11708, first column, to page 11709, second column). This process differs from the instantly claimed invention in at least two important aspects. First, the instantly claimed process does not transfer the reaction support prior to collecting the reaction product. Secondly, the instantly claimed process collects the product on a collection plate adjacent to a second surface of the reaction support. The cited art simply does not cure the defects in the teachings of the Nishioka patent and the Baldeschwieler patent. Furthermore, even if one were to combine the teachings of the cited art, one would not arrive at any claimed invention. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 28, 30, 31, 33, 34, and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over the Brennan patent or the Winkler patent in view of the admitted state of the prior art, U.S. Patent No. 4,923,901 (“the Koester patent”) and Salmon, *et al. Proc. Natl. Acad. Sci. USA* **1993**, 90, 11708-12 (“the Salmon article”). For reasons completely analogous to those discussed for the alleged anticipation based on the Nishioka patent and the Baldeschwieler patent, Applicants submit that this rejection should be withdrawn.

Claims 26-42 stand rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-11 of U.S. Patent No. 5,925,732. Although Applicants do not necessarily agree with the rejection, a terminal disclaimer is submitted herewith in order to further prosecution.

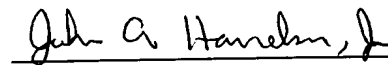
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Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

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